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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,214	07/25/2001	Theodore C. Johnson	37167-8040.US00	6833
22918	7590	12/10/2003	EXAMINER	
PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026			PEFFLEY, MICHAEL F	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/916,214

Applicant(s)

JOHNSON ET AL. *CH*

Examiner

Michael Peffley

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 38-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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Applicant's amendments and comments, received October 17, 2003, have been fully considered by the examiner. In particular, applicant's amendments have overcome the 35 USC 112 rejections. The following is a complete response to the October 17, 2003 communication.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 38-42 and 45-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Gough et al ('384).

Gough et al provide a device which comprises an elongate delivery device (18) maneuverable in tissue, and a plurality of resilient members (16) which are deployable into tissue with curvature. The resilient members are RF electrodes which may be used to treat tissue, and the electrodes include sensors (24) for measuring tissue impedance and using that measurement to monitor the ablation of tissue and control the delivery of RF energy. A multiplexer is used to control the delivery of data between the multiple resilient members (see col. 9, lines 37-40). Resources are provided for using the impedance data to control the procedure (Figures 9 and 10). It is noted that many of the claims include recitation of the device "configured to" perform various functions. This language is not deemed to present any specific structure or means supportive of

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the recited functions, and the Gough et al system is deemed to be capable of performing these functions.

Claims 38-42 and 45-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Gough et al ('484).

Gough et al provide a device substantially identical to the Gough et al ('384) device. It includes an elongate delivery device and a plurality of resilient members (16) which are deployable into tissue with curvature. The resilient members are RF electrodes which may be used to treat tissue, and the electrodes include sensors (24) for measuring tissue impedance and using that measurement to monitor the ablation of tissue and control the delivery of RF energy. A multiplexer is used to control the delivery of data between the multiple resilient members (see col. , lines 40-45). Resources are provided for using the impedance data to control the procedure (Figures 9 and 10). It is noted that many of the claims include recitation of the device "configured to" perform various functions. This language is not deemed to present any specific structure or means supportive of the recited functions, and the Gough et al system is deemed to be capable of performing these functions.

***Allowable Subject Matter***

Claims 43 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed October 17, 2003 have been fully considered but they are not persuasive.

Applicant contends that the Gough et al ('384) reference teaches the multiplexing of energy delivery between the primary and secondary antennas. The examiner maintains that Gough et al make it clear that energy delivery may be made not only between the primary antenna and the secondary antennas, but also between the various secondary antennas (see col. 8, lines 30-35). The examiner maintains that the use of the multiplexor to delivery signals to the secondary antennas would be inherent.

Further, the Gough et al ('484) reference has been added in a separate rejection. This device is substantially equivalent to the Gough et al ('384) device, but more specifically teaches of the multiplexing of signals between the secondary antennas (i.e. resilient members). See column 7, lines 40-45.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

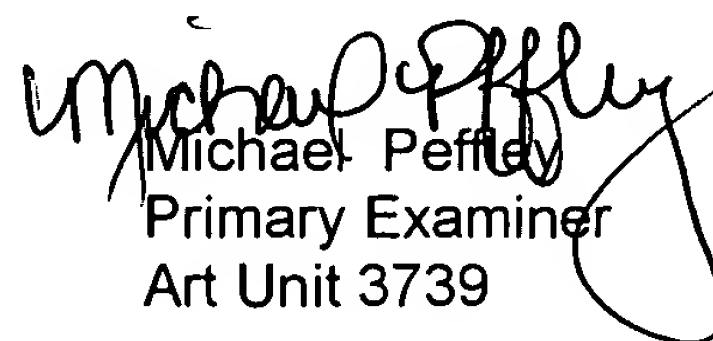
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
December 8, 2003